

### REMARKS

In response to the Office Action dated March 31, 2008, claims 1, 14 and 42 have been amended. Claims 1-52 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

#### A. Rejection of claims 1-52 under 35 U.S.C. 112

The Office Action rejected claims 1-52 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, on page 2 of the Office Action dated March 31, 2008, the Examiner stated that the "...spec merely suggest that non-time stamped elements can be separated and be placed at the beginning or end of the timeline but fails to provide a detailed description of automatic separation, e.g., by which way such a function is being performed and by which means."

The Applicants respectfully traverse this rejection and submit that the subject matter of the claims comply with 35 U.S.C. 112, first paragraph.

Namely, support for the claims can be found throughout the specification and at least in FIGS. 1-3 and paragraphs [0032], [0036], [0038] and [0041] - [0043] of the Application specification (U.S. Patent Publication No. 2004/0205479). For instance, paragraph [0036] does not merely suggest, but in fact explicitly states that "...the presentation creation system 110 **automatically composes an initial presentation by sorting the identified media elements** from block 206 according to the selected control settings from block 204....The term **"automatically" in this context indicates the ability to create a presentation without further input from the user** after the user indicates completion of the media element identification process of block 206 or that they have completed the editing process of block 214." [emphasis added].

Moreover, paragraph [0038] of the Applicants' specification explicitly states that if "...there are image elements, such as digital still images and digital vid-images, that do not have time stamps, the presentation creation system 110 may place the non-stamped image elements **at the beginning, or end,** of the initial presentation according to a **control setting** determined in block 204. Alternatively, the presentation creation system 110 may **separately group the non-stamped**

**image elements for the user to place in the presentation in a later step**, such as the editing of block 214. The presentation creation system 110 completes the composition of the image-track when the images from the media elements identified in block 206 are all placed on the image-track or grouped for insertion in another block of the process." [emphasis added].

Further, paragraph [0043] explicitly states that "...some image boxes, such as first image box 310 and second image box 312, **may overlap** on the image line 304. **Such overlaps may occur if, for example, but not limited to, the image elements were recorded contemporaneously, or if the time stamp associated with the image element has been changed in block 206, or if the time stamp was changed** due to an edit in block 214. In these situations, the image elements may have overlapping time stamps associated with the digital data corresponding to the image elements." [emphasis added]. Thus, the specification would be readily understood by any skilled software programmer. Examiners can only reasonably doubt an invention's asserted utility if the written description "suggests an inherently unbelievable undertaking or involves implausible scientific principles," which is clearly not the case here. In re Cortright, 49 USPQ 2d 1464, 1466 (Fed. Cir. 1999).

The Federal Circuit has clearly stated that patent applications should be written for persons familiar with the relevant field; the patentee is not required to include in the specification specific programming code as long as the concept is readily understood by practitioners. Otherwise, every patent would be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. Verve LLC v. Crane Cams Inc., 311 F.3d 1116, 65 USPQ 2d 1051, 1053-54 (Fed. Cir. 2002). The court in Enzo Biochem, Inc. v. Calgene, Inc., 52 USPQ 2d 1129, 1135-36 (Fed. Cir. 1999) concluded that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, as long as the experimentation is not undue.

Thus, although the specification does not provide detailed computer programming code to perform the elements in the claims, according to well settled case law, this is not required. Consequently, even though the Examiner's statement that the "...spec merely suggest that non-time stamped elements can be separated and be placed at the beginning or end of the timeline but fails to provide a detailed

description of automatic separation, e.g., by which way such a function is being performed and by which means," is incorrect, the Applicants specification provides sufficient support under 35 U.S.C. 112, first paragraph for all of the claimed elements. Hence, the Applicants respectfully submit that the original specification complies with the written description requirement with respect to claims 1-52 and the rejection is in error.

**B. Rejection of claims 1-17 and 42-58 under 35 U.S.C. 101**

The Office Action rejected claims 1-17 and 42-48 under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter.

In response, the Applicants have amended applicable claims as suggested by the Examiner to overcome these rejections.

**C. Rejection of claims 1-52 under 35 U.S.C. 103**

The Office Action rejected claims 1-52 under 35 U.S.C. 103(a) as allegedly being unpatentable over Reid (U.S. Patent No. 7,325,199) in view of Balkus et al. (U.S. Patent Publication No. 2004/0268224).

The Applicants respectfully traverse this rejection based on the amendments to the claims and the arguments below.

Specifically, the combined cited references do not disclose, teach or suggest this feature of the Applicants' newly claimed invention. For example, the combined cited references merely a system with time-stamped features (see Abstract of Balkus et al.) and overlapping clips on different tracks (see paragraph [0115] of Miller et al.). As such, clearly, the combined cited references are missing at least the Applicants' automatically overlapping media elements on a same image track that were recorded contemporaneously of the independent claims.

Support for this feature can be found throughout the specification and at least in FIG. 3 and paragraphs [0037] and [0043] of the Application specification (U.S. Patent Publication No. 2004/0205479). In particular, paragraph [0037] states that the "...initial presentation preferably comprises an image-track and a soundtrack. The image-track is the visual portion of the presentation." In addition, paragraph [0043] states that "...some image boxes, such as first image box 310 and second image box 312, may overlap on the image line 304. Such overlaps may occur if, for

example, but not limited to, the image elements were recorded contemporaneously..." Hence, since the original specification discloses two tracks, an audio track and an image track (only one track for images - see paragraph [0037]), and because **overlaps can occur with images** that were recorded contemporaneously (see paragraph [0043]), the claimed feature of automatically overlapping media elements **on a same image track** that were recorded contemporaneously is supported by the original specification.

Further, even though the combined references do not disclose, teach, or suggest the Applicants' claimed invention, the references should **not** be considered together because Miller et al. teach away from the Applicants' claimed invention. For example, Miller et al. **explicitly** disclose that "[i]f a track contains more than one source clip, the source clips *cannot overlap*. If source clips are to overlap (e.g. fading from one source to another, or having one source obscure another), then *multiple tracks* are used." see paragraphs [0187] and [0189] of Miller et al.). However, the Applicants' claimed invention discloses that the media elements automatically overlap **on a same track** that were recorded contemporaneously.

Moreover, Miller et al. **explicitly** disclose that "...the source clips **must occur next to one another** in the project, (2) the clips appear next to one another in the source, and (3) the clips must share a common pre-processing source chain (i.e., **must require** the same pre-processing)," which is very different from the Applicants' claimed which allows "automatically separating non-time stamped media elements and automatically place the non-time stamped media elements at the beginning or end timeline location according to control settings."

Therefore, the proposed modification or combination would render Miller et al. being modified unsatisfactory for its intended purpose and would change the principle of operation of the invention in Miller et al. being modified because Miller et al. explicitly cannot overlap source clips on the same track and separation of media elements cannot occur since Miller et al. disclose that source clips must occur next to one another. Since the Applicants' claimed elements are not disclosed, taught or suggested by the combined references and because Miller et al. teach away from the Applicant's invention, Miller et al. cannot be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejections should be withdrawn. *MPEP 2143*.

With regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). The other references cited by the Examiner also have been considered by the Applicants in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicants' claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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